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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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|-----------------|-------------|----------------------|---------------------|------------------|

10/748,211

12/31/2003

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07/07/2006

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EXAMINER

LEE, EDMUND H

ART UNIT

PAPER NUMBER

1732

DATE MAILED: 07/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/748,211

Applicant(s)

PUNIELLO ET AL.

Examiner

EDMUND H. LEE

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>12/20/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claim 13 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in the reply filed on 5/3/06.

2. Applicant's election without traverse of claims 1-12 and 14 in the reply filed on 5/3/06 is acknowledged.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lammi (USPN 5783293) in view of Maruko et al (USPN 5823890). In regard to claim 1, Lammi teaches the basic claimed process including a method of forming a golf ball (col 5, lns 1-39; figs 1-8); forming a core (col 5, lns 1-39; figs 1-8); forming a multi-layer over the core (col 5, lns 1-39; figs 1-8); selecting a material (col 5, lns 1-39; figs 1-8); providing a first portion of the material (col 5, lns 1-39; figs 1-8); providing a second portion of the material (col 5, lns 1-39; figs 1-8); and injecting the first and second materials to form the multi-layers (col 5, lns 1-39; figs 1-8). Lammi, however, does not teach a multi-color layer; providing a first portion of the material with a first pigment additive; and providing a second portion of the material with a second pigment additive, the second pigment being a different color than the first pigment additive. Maruko et al

Art Unit: 1732

teaches a golf ball (col 1, Ins 38-42); and a multi-color cover layer, wherein the layers have different colors. Maruko et al also inherently teaches that color additives were used. Lammi and Maruko et al are combinable because they are analogous with respect to golf balls. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to color the cover layers of Lammi as taught by Maruko et al in order to form a good appearing golf ball. In regard to claims 2-5,7-9,12 and 14, such are taught by Lammi (col 5, Ins 1-39; figs 1-8). In regard to claims 6,10 and 11, Lammi does not teach forming an outer cover layer and an inner cover layer of substantially the same thickness; forming a substantially white first portion; and forming a substantially translucent cover over the multi-color layer. In regard to forming an outer cover layer and an inner cover layer of substantially the same thickness, such is a mere obvious matter of choice dependent on the desired final product and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, golf balls having an outer cover layer and an inner cover layer of substantially the same thickness are well-known in the golf ball art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form the inner and outer cover layers of Lammi with substantially the same thickness in order to form a golf ball having a specific playing characteristic. In regard to forming a substantially white first portion, such is a mere obvious matter of choice dependent on the desired final product and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, golf balls having a substantially white cover layer are well-known in the golf ball

art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to color the first portion of Lammi white in order form a good appearing golf ball. In regard to forming a substantially translucent cover over the multi-color layer, such is well-known in the golf ball art in order to form a good appearing golf ball. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form a substantially translucent cover over the multi-color layer of Lammi (modified) in order to form a good appearing golf ball.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following US patents illustrate the state of the art: 6435984; and 6022279.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDMUND H. LEE whose telephone number is 571.272.1204. The examiner can normally be reached on MONDAY-THURSDAY FROM 9AM-4PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on 571.272.1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1732

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EDMUND H. LEE
Primary Examiner
Art Unit 1732

EHL



6/26/06